

### **Remarks**

By this Amendment, claim 4 has been amended and claims 39-42 have been added to the present application. After entry of this amendment, claims 1-11, 14, 17, 18, 22, 25-27, 30, 32, 34, and 36-42 will be pending in the present application. Applicant requests reconsideration in view of the amendments and the following remarks.

### **Telephone Interview**

Applicant's representative discussed the present application in a telephone interview with Examiner Kiliman on May 29, 2007. The substance of the interview is discussed below.

### **Rejection of Claims 1-11, 14, 17, 18, 22, 25-27, 30, 32, 34 and 36-38**

Claims 1-11, 14, 17, 18, 22, 25-27, 30, 32, 34 and 36-38 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. RE37,645 to Takahashi (Takahashi). Applicant traverses this rejection and requests that it be withdrawn.

### **Examiner's Position**

In the telephone interview, the Examiner informed Applicant's representative that throughout the pending claims he has interpreted the phrase "marking-erasable coating" ("MEC") to mean ink markings or printed images made on a piece of paper. For example, the Examiner considers ordinary office printer ink to be a MEC when printed on ordinary printer paper. Therefore, the pending claims are allegedly anticipated by Takahashi because this reference describes a process for removing the ink from paper. In reply, applicant submits that the foregoing construction of the phrase "marking-erasable coating" is incorrect, and therefore Takahashi does not anticipate the pending claims.

### **Meaning of "Marking-Erasable Coating"**

MPEP §2111.01(I) states that claim limitations must be given their "plain meaning" unless such meaning is inconsistent with the specification. Further, the "plain meaning" refers to the meaning that the term would have to a person of ordinary skill in the art. MPEP §2111.01(III). As discussed in the interview, the plain meaning of the phrase "marking-erasable coating" is "a coating that can have a marking erased from it," not the markings themselves. Specifically, the language "marking-erasable" is a combination of a noun and an adjective joined

together with a hyphen to form a single adjective that modifies the noun “*coating*” such that the limitation “marking-erasable coating” refers to a *coating* that is *marking-erasable*. The claim construction proposed by the Examiner would make sense only if the claims recited a coating of erasable markings.

In addition, the Background section of the present application states that an “erasable surface” is a surface to which liquid ink can be applied and then removed with relative ease and without causing significant damage. Page 1, lines 12-13 of the present application. Thus, a person of ordinary skill in the art would understand that a MEC is a coating of the paper from which markings can be erased, not the markings or images on a piece of paper. The specification of the present application further supports the claim construction that a MEC is a coating of a paper product that is marking-erasable.

For example, as described on page 8, line 30 through page 9, line 1 and shown in FIG. 1, a paper product 10 can comprise a base sheet 12 and a marking-erasable coating 14 formed over the base sheet. As described in the examples disclosed throughout the application (see, for example, pages 17 through 25), the erasability of various coatings were demonstrated by applying ink to the coatings and then erasing the markings. A person of ordinary skill in the art clearly would understand that a marking-erasable coating, such as coating 14 shown in FIG. 1, is a coating of the paper to which markings are applied.

Takahashi Does Not Anticipate Independent Claims 1, 25, 36, and 38

Independent claims 1, 25, 36, and 38 recite a paper product comprising “a marking-erasable coating.” It was discussed and agreed upon in the telephone interview that Takahashi describes a method and apparatus for removing ink markings from paper but that Takahashi does not teach or suggest a MEC that is a component of the paper product itself and from which markings can be erased. Because Takahashi does not teach or suggest a paper product comprising a marking-erasable coating, the rejection of claims 1, 25, 36, and 38 should be withdrawn.

Further, independent claim 36 also recites “a writing instrument that can be used to create erasable marks on the paper product.” Even assuming for purposes of discussion only that ink markings or printed images on a piece of copy paper such as disclosed in Takahashi constitutes a marking-erasable coating, Takahashi does not anticipate claim 36 because it does not teach or

suggest a writing instrument that can be used to create erasable marks on the “marking-erasable coating” (the printed image on the piece of paper).

#### Dependent Claims

Dependent claims 2-11, 14, 17-18, 22, 26-27, 30, 32, 34, and 37 depend from claims 1, 25, and 36 and therefore are patentable for at least the reasons given above in support of their base claims and because each dependent claim sets forth an independently patentable combination of features.

#### Dependent Claim 4

For example, dependent claim 4, as amended, recites: “wherein the marking-erasable coating has a surface and is configured so that liquid ink from a black dry erase marker can be applied to the surface of the marking-erasable coating, allowed to dry, and then erased with a dry cloth, where the liquid ink has a marker density greater than about 0.5 after drying and a residual marker density less than about 0.1 after being erased” (added language underlined).

First, as noted above, Takahashi does not teach or suggest a paper product comprising a marking-erasable coating. Second, Takahashi does not teach or suggest erasing ink from a marking-erasable coating with a dry cloth, as required in claim 4. At best, Takahashi teaches removing ink from a piece of paper using a liquid solvent. Accordingly, claim 4 is not anticipated or rendered obvious by Takahashi and the rejection should be withdrawn.

#### Dependent Claims 9, 10, 22, 26, and 27

Dependent claims 9, 10, 26, and 27 recite specific features of the paper product that are clearly absent from Takahashi. Claims 9 and 26 include the limitation that “the paper product has a Gurley density greater than about 1,000 seconds.” Claims 10 and 27 include the limitation that “the paper product has a Sheffield Smoothness less than about 200 cubic centimeters per minute.” Claim 22 recites that “where the marking-erasable coating has a substantially continuous surface that contains substantially no surface-exposed pigment particles.” None of these features of a paper product are taught or even suggested by Takahashi. If the rejection of these claims is not withdrawn, Applicant requests the examiner to explain the relevance of Takahashi with respect to these claims.

**Conclusion**

The present application is in condition for allowance and such action is respectfully requested. If any further issues remain concerning this application, the Examiner is invited to call the undersigned to discuss such matters.

Respectfully submitted,

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